

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111

Serial Number: 09/732,241

Filing Date: December 7, 2000

Title: THERAPEUTIC CARBAMATES

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Dkt: P-095-R

### REMARKS

This is in response to the non-final Office Action mailed on June 5, 2003. Applicant respectfully requests reconsideration in view of the amendments and remarks herein.

Claims 1, 2, 15, 16, 17 and 18 have been amended and claims 27 and 35 have been cancelled. As a result, claims 1-26, 28-34, and 36-52 are pending. It is noted that claims 2, 5, 8, 17-23, 26-46 and 52 were withdrawn from consideration by the Examiner. This is discussed below. No new matter has been added by the above amendments.

Applicant would like to thank Supervisory Examiner Alan L. Rotman for the courtesy extended during a telephonic interview on 14 July 2003. On 10 July 2003, the below signed attorney Harris called Examiner Raymond K. Covington (703-308-4704) to discuss two proposed amendments related to the outstanding rejection under 35 U.S.C. § 112. Examiner Covington recommended calling Supervisory Examiner Rotman directly to discuss the amendments.

On 14 July 2003, attorney Harris discussed the proposed amendment with Supervisory Examiner Rotman (703-308-4698). Attorney Harris suggested:

1) inserting the linker definition from claim 27 into claim 1 to overcome the 35 U.S.C. §112 second paragraph rejection at page 2, paragraph 2 of the Office Action; and 2) replacing the phrases "attaches (a)" and "attaching (a)" with the phrase "attaches a group of formula (a)" to overcome the 35 U.S.C. §112 second paragraph rejection at page 2, paragraph 3. Supervisory Examiner Rotman agreed that such amendments would be considered if presented.

Attorney Harris and Supervisory Examiner Rotman also discussed the withdrawal of claims 2, 5, 8, 17-23, 26-46 and 52 from consideration in the Office Action. Attorney Harris pointed out that many of these claims read on the elected species. Supervisory Examiner Rotman stated that the withdrawal of these claims was inappropriate, since no restriction requirement had been made. Supervisory Examiner Rotman suggested that Applicant address this point in his response and request rejoinder and examination of these claims.

The above account is believed to be a complete and accurate summary of the telephonic interview as required by 37 C.F.R. §1.133. If the Examiner believes that this summary is inaccurate or incomplete, Applicant respectfully requests that the Examiner point out any deficiencies in his next communication so that Applicant can amend or supplement the interview

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summary.

§112 Rejection of the Claims

Claims 1, 3, 4, 6, 7, 9-16, 24, 25 and 47-51 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is respectfully traversed.

Claim 1 has been amended to incorporate the definition of "X" from claim 27, which was not included in the rejection. For the Examiner's convenience, it is noted that two of the groups in the definition for Y<sup>a</sup> and Y<sup>b</sup> (-N=C(X<sup>a</sup>)-NR'- and -NR'-C(X<sup>a</sup>)=N-) from claim 27 have also been removed from the definition for Y<sup>a</sup> and Y<sup>b</sup> in claim 1. Withdrawal of the rejection is respectfully requested.

Claim 1 was also rejected under 35 U.S.C. § 112, second paragraph, because of the phrase "attaches (a)". Claim 1 has been amended by replacing this phrase with the phrase "attaches a group of formula (a)". The L<sub>1</sub> definition in claim 1 recites that L<sub>1</sub> is "a group of formula (a)." Thus, it is respectfully submitted that this phrase has clear antecedent when recited later in the claim. Accordingly, the Examiner's ground for rejection under 35 U.S.C. § 112 has been obviated. Applicant respectfully requests withdrawal of the rejection. It is noted that claims 15-18 have been amended in a similar manner.

It is also noted that examined claim 2 recited "attaching (b)", "attaching (c)", "attaches (c)", and "attaches the (d)". Claim 2 has been amended for consistency and to insure these terms have proper antecedent basis.

Claims Withdrawn from Consideration by the Examiner

Claims 2, 5, 8, 17-23, 26-46 and 52 were withdrawn from consideration by the Examiner. During the above referenced telephone call, Supervisory Examiner Rotman stated that this withdrawal was inappropriate since no requirement for restriction had been made. As suggested by Supervisory Examiner Rotman, Applicant respectfully requests rejoinder and examination of these claims.

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Conclusion

In view of the above amendments and remarks, Applicant respectfully requests withdrawal of the rejections and allowance of claims 1-26, 28-34, and 36-52. The Examiner is invited to telephone Applicant's attorney (612-359-3265) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

MATHAI MAMMEN ET AL.

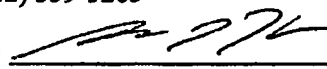
By their Representatives,

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Date

9-5-03

By



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I hereby certify that this paper is being transmitted by facsimile to the U.S. Patent and Trademark Office on the date shown below.



Dawn M. Poole

9/5/03

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